



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,509	09/29/2000	Chandler Fulton	030598.0028.UTL1	1879
30542	7590	05/09/2006	EXAMINER	
FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			TON, THAIAN N	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/675,509

Applicant(s)

FULTON ET AL.

Examiner

Thaian N. Ton

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,10,11,18,19,25-27 and 32.

Claim(s) withdrawn from consideration: 16,17 and 20-24.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Anne-Marie Falk
ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER

Continuation of 3. NOTE: The proposed claim amendments require further consideration and/or search. In particular, the proposed amendment to claim 18 recites a portion of the *N. gruberi* thiaminase sequence of SEQ ID NO: 3, at least 200 nucleotides in length. This would require further search and/or consideration. Dependent claims would also require further search and consideration in view of this amendment.

Continuation of 11. does NOT place the application in condition for allowance because:

NOTE: The Amendment has not been entered, therefore all prior rejections of record are maintained. The Examiner addresses Applicants' remarks/arguments with respect to the prior rejections. The Obviousness-Type Double Patenting rejection of claims 1, 3, 10, 11 and 25-27 is maintained, as no terminal disclaimer over these claims have been presently filed. The prior rejection of claims 1, 3, 25-27 and 32, under 112, 1st paragraph, for new matter, is maintained because the amendment is not entered, thus, the prior rejection is maintained with regard to the limitation of "non-pathogenic". The prior rejection of claims 1, 3, 11, 25-27 and 32 is maintained for lack of enablement, for reasons of record. The claims are only enabled for SEQ ID NO: 3, which encodes thiaminase I from *N. gruberi*, vectors containing said nucleic acid sequence, operably linked to a promoter, cells transformed in vitro by said vector, and specifically recited bacterium comprising said sequence (see page 7 of the prior rejection, mailed 1/25/06). The proposed claim amendments are not entered, thus Applicants' arguments regarding the claims not being directed to in vivo methods is not found to be persuasive, as the claim set clearly recites these embodiments (see claims 1 and 3). Accordingly, all rejections of record are maintained.